

Attorney Docket: 012.P10010

**REMARKS**

Claims 1-65 are pending in the above-referenced patent application. In this amendment, claims 35 and 52 have been amended.

In the Office Action, dated December 1, 2005, the Examiner allowed claims 1-34, 48-51 and 53-65; rejected claims 35-47 and 52 under 35 U.S.C 112, second paragraph; and rejected claims 35-47 under 35 U.S.C 101, for being directed to non-statutory subject matter. The rejections to claims 35-47 under 35 U.S.C 101 are respectfully traversed.

Assignee would like to thank the Examiner for finding patentable subject matter. Additionally, Assignee has addressed the rejection of claims 52 and 35-47 under 35 U.S.C 112, second paragraph, by amending claim 52 to indicate proper dependency, and by amending claim 35 in accordance with Examiner's suggestion. Therefore, it is respectfully requested that the Examiner withdraw this rejection of claims 52 and 35-47.

Assignee respectfully submits that claims 35-47 are directed to statutory subject matter, and, therefore, the rejection of these claims under 35 U.S.C 101 is improper. Assignee respectfully notes that a recent decision by the Board of Patent Appeals and Interferences, *Ex Parte* Carl A. Lundgren, Appeal No. 2003-2088 (Bd. Pat. App. & Interf. September 2005) resulted in the issuance of interim guidelines for relating to subject matter eligibility. The interim guidelines, titled, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility", issued on October 26, 2005, state, in part:

c. (i) The Mental Step Test: If a claimed process is performed by a machine, it is immaterial whether some or all the steps could be carried out by the human mind. As stated in *Musgrave*, 431 F.2d at 893, 167 USPQ at 289-90: "[w]e cannot agree with the board that these claims (all the steps of which can be carried out by the disclosed apparatus) are directed to non-statutory processes merely because **some or all** [emphasis added] the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think." Therefore, USPTO personnel should no longer rely on the mental step test to determine whether a claimed invention is directed to statutory subject matter. If all the steps of a claimed process can be carried out in the human mind, examiners must determine whether the claimed process produces a useful, tangible, and concrete result, i.e., apply the practical application test set forth in *State Street*.

Attorney Docket: 012.P10010

It is respectfully submitted that in light of the above-noted guidelines, the Examiner has failed to establish a prima facie case of non-statutory subject matter. In particular, the Examiner has failed to establish that the rejected claims fall into a judicially created exception to statutory subject matter. The Examiner submits that the rejected claims comprise a plurality of mental steps that are non-statutory subject matter. While Assignee does not agree with the Examiner's position, it is pointed out that In re Lundgren rejects the mental step test applied by the Examiner. Therefore, regardless of whether the Examiner's assertion is correct, which Assignee disputes, it would not matter since this test is no longer an applicable test.

Therefore, it is respectfully submitted that the rejection to claims 35-47 under 35 U.S.C 101 is an application of a "Mental Step Test", which, as noted above is no longer to be relied upon, and is, therefore, improperly applied to the pending claims. It is respectfully submitted that claims 35-47 are directed to statutory subject matter, and are in a condition for allowance. It is, therefore, respectfully requested that the Examiner withdraw the rejections of these claims.

Attorney Docket: 012.P10010


**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application, as amended, are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3703.

Respectfully submitted,

Dated: 3/1/06

  
Michael J. Willardson  
Patent Attorney  
Reg. No. 50,856

Berkeley Law and Technology Group, LLC  
1700 NW 167th Place, Suite 240  
Beaverton, OR 97006